

ESTTA Tracking number: **ESTTA699622**

Filing date: **10/01/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223191
Party	Plaintiff Rive Gauche Jewelry Inc.
Correspondence Address	Ursula B. Day Law firm of Ursula B. Day 708 Third Avenue Suite 1501 New York, NY 10017 UNITED STATES patentlaw@ursuladay.net
Submission	Other Motions/Papers
Filer's Name	Ursula B. Day
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Date	10/01/2015
Attachments	OPPOSERSOPPOSITION.pdf(522676 bytes)

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Attorney for Opposer
Rive Gauche Jewelry, Inc.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----X		
RIVE GAUCHE JEWELRY, INC.,	}	
	}	
Opposer,	}	
	}	
v.	}	Mark: RIVE GAUCHE (stylized)
	}	Serial No. 86327529
	}	Opp. No. 91223191
LUXURY GOODS	}	
INTERNATIONAL (L.G.I.), S.A.,	}	
	}	
Applicant.	}	
-----X		

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

Opposer, Rive Gauche Jewelry, Inc. ("Rive Gauche" or "Opposer") by and through its undersigned counsel, hereby submits this opposition, together with the attached Declaration of Ursula Day ("Day Decl."), to Applicant Luxury Goods International (L.G.I.), S.A. ("L.G.I." or "Applicant")'s Motion to Dismiss Opposer's Notice of Opposition.

I. PROCEDURAL AND FACTUAL BACKGROUND

Applicant filed Trademark Application No. 86327529 with the United States Patent and Trademark Office ("USPTO") on July 2, 2014, in its attempt to register the stylized "Rive Gauche" Mark (the "Mark") in Applicant's name. The Mark was published in the *Official*

Gazette on June 9, 2015. The initial deadline to oppose, pursuant to the Lanham Act and Trademark Rules, was July 9, 2015. On July 9, 2015, pursuant to Trademark Rule 2.102, Opposer's counsel filed with the USPTO a First 30 Day Request for Extension of Time to Oppose on Opposer's behalf, which was duly granted. Thus, the time to oppose the Mark was extended until August 8, 2015.

On August 7, 2015, prior to the deadline to oppose, counsel for Opposer filed and served Notice of Opposition No. 91223191, citing priority and likelihood of confusion. The Notice of Opposition was filed via the Electronic System for Trademark Trial and Appeals ("ESTTA"), with a Certificate of Service indicating service on Applicant's counsel by facsimile or e-mail. See Day Decl. ¶ 2. On that same day, the undersigned e-mailed the Notice of Opposition to Applicant's counsel of record and advised Applicant's counsel that a hard copy of the Notice of Opposition was in the mail. See Id. ¶ 3; Exhibit A. Applicant's counsel confirmed receipt of the e-mailed Notice of Opposition shortly after the e-mail was sent. See Day Decl. ¶ 4. A copy of the Notice of Opposition was put in the mail with the U.S.P.S. on August 7, 2015. See Id. ¶ 3.

Applicant's counsel then waited another month before notifying Opposer's counsel on September 9, 2015, that it never received a hard copy of the Notice of Opposition. See Id. ¶ 5. This was the first time Opposer's counsel learned this fact. See Id. In an effort to cure any possible technical defect, the undersigned immediately mailed another copy of the Notice of Opposition to Applicant's counsel via U.S.P.S. Express Mail on the same day the undersigned learned of the defect, i.e., September 9, 2015. See Id. ¶ 6. This copy was received by Applicant's counsel the following day, September 10, 2015. See Id. ¶¶ 7, 8.

II. Argument

The requirements for proper services of process have been substantially met in this case, and any defect is negligible given that Applicant's counsel did actually receive the Notice of Opposition within the time to oppose, and any procedural defect was curable and was cured immediately upon learning of the defect.

Trademark Rule 2.101 provides a two-step process to effectively commence an opposition proceeding: "(1) opposer makes sufficient efforts to serve the notice of opposition and (2) the Board is notified of the service at the time the notice of opposition is filed." Chocoladefabriken Lindt & Sprungli AG v. Karlo Flores ("Lindt"), 91 U.S.P.Q.2d (BNA) 1698, 1699 (TTAB 2009); 37 C.F.R. § 2.101. Both steps have been met here. Opposer will address both steps in reverse order for simplicity sake, just like the Lindt Court did.

(A) The Board Was Notified of Service at the Time the Opposition Was Filed

Despite Applicant's protestations, the second step is met automatically when an Opposer files a Notice of Opposition through ESTTA. "By utilizing ESTTA to file its notice of opposition, opposer was assured that the notice of opposition would contain a certificate of service attesting to service. 'Any plaintiff who files through ESTTA is viewed by the Board as having included proof of service with its pleading.'" Id. (quoting Schott AG v. L'Wren Scott, 88 U.S.P.Q.2d 1862, 1863 n.3 (TTAB 2008) (internal brackets omitted). Opposer filed its Notice of Opposition within the opposition period via ESTTA, and therefore, the Certificate of Service included on the ESTTA Notice form satisfies this step. See Day Decl. ¶ 2.

(B) Opposer Made Sufficient Efforts to Serve the Notice of Opposition

The only real issue here is "whether opposer's failure to serve the complaint on applicant's [attorney's] correspondence address of record . . . nullifies the opposition." Lindt, 91

U.S.P.Q.2d at 1699. The Board in Lindt held that the failure to comply perfectly with the procedure did not mandate dismissal of the opposition as a nullity, since (1) Applicant's counsel actually received and was on notice of the Notice of Opposition during the opposition period and (2) the "opposer moved promptly to cure the technical deficiency of service" as soon as it learned of the error. Id. at 1700. As the facts of the present case are closely analogous to the Lindt case, the Board should extend that decision to this matter.

In Lindt, the issue of effective service arose when Opposer's attorney served the notice on the applicant at the applicant's own business address, when the "correspondence address of record" was applicant's attorney's address and the Trademark rules require a copy of the opposition to be served "at the correspondence address of record." See Id. 1698–1700; 37 C.F.R. § 2.101(b). Opposer did not learn of its error until it received Applicant's answer and affirmative defenses. See Id. at 1700. "Immediately" upon learning of the technical deficiency, opposer served a copy of the opposition at the correspondence address, but "this service was not effected until after the opposition period had closed." Id. Applicant then moved to dismiss for ineffective service of process, which was denied by the Board.

Whereas in Lindt, the notice was served on and actually received at the incorrect mailing address, here the notice was served on and actually received at an e-mail address, which was the e-mail address on record but was not based on consent, and thus, amounts to actual service by inappropriate means. Importantly, though the Certificate of Service only indicates service by facsimile or e-mail, Opposer's Counsel did attempt to fully comply with Trademark Rule 2.101(b) by placing the Notice of Opposition in the mail for delivery via U.S.P.S. See Day Decl. ¶ 3. The Notice of Opposition was e-mailed to Applicant's counsel and placed in the mail on August 7, 2015, which was before the August 8, 2015 deadline. See Id. Thus, the Notice of

Opposition was timely filed and served, regardless of whether Applicant's counsel received a mailed copy within that time frame. See Lindt, 91 U.S.P.Q.2d at 1699, n.3 ("The filing date of an opposition is the date of receipt in the Office of the opposition, with proof of service, together with the required fee."); Musical Directions v. McHugh, 104 U.S.P.Q.2d 1157, 1159 (TTAB 2012) (Trademark Rule 2.101(b) "does not require an opposer to provide proof of receipt of a notice of opposition, but only proof of service thereof."); 37 C.F.R. §§ 2.101(d)(4). More important on this motion to dismiss is that Applicant's counsel actually received the Notice of Opposition and had actual notice of its filing and contents, even if actual service was defective. See Day Decl. ¶ 4.

Moreover, upon learning of the technical deficiency, i.e., that a copy of the notice was not received at the "correspondence address of record," Opposer immediately cured this deficiency by placing a copy of the notice in Express Mail on the same date that Applicant's counsel first contacted Opposer's counsel, September 9, 2015, which was received by Applicant the very next day. See Day Decl. ¶¶ 5–7, Decl. of Jess Collen ¶¶ 7–10. The Board should note the immediacy of the attempt to cure the technical defect and the actual service by e-mail. As the Board has noted, the "purpose of service in a Board proceeding is to provide notice of the action," and thus, "there is a distinction between a complete lack of actual service and defective but curable actual service." Lindt, 91 U.S.P.Q.2d at 1700.

Thus, in both Lindt and the current matter, there was "defective but curable actual service," that (1) put Applicant's counsel on actual notice of the filing and contents of the Notice of Opposition, and (2) was cured as soon as the technical deficiency was learned. Under these circumstances, the Board held in Lindt that "the opposition may go forward on the pleadings of record" without the need to re-serve a copy of the notice of opposition. Id.

Finally, Applicant's reliance on Musical Directions is misplaced, since Applicant's attempt to distinguish that case is based on an inaccurate understanding of the facts. The sum and substance of Applicant's complaint is that it did not receive a copy of the opposition by mail within the opposition period. Applicant's counsel even acknowledges that service via e-mail without consent is not grounds in and of itself for dismissal. See Applicant's Motion to Dismiss p. 5 (quoting Musical Directions, 104 U.S.P.Q.2d at 1159). Applicant only distinguishes Musical Directions based on Applicant's belief that the notice was not mailed. However, Opposer's counsel did attempt to mail a copy within the opposition period. See Day Decl. ¶ 3. That it was not received does not render the opposition a nullity, particularly since Applicant's attorney actually received a copy. See Id. ¶ 4; Musical Directions, 104 U.S.P.Q.2d at 1159 ("Although applicant did not in fact receive the copy of the notice of opposition sent through the Postal Service, we find no harm to applicant under the circumstances inasmuch as applicant clearly knew about the notice of opposition and its contents."). Further, unlike in Musical Directions, where the notice was returned to opposer as undeliverable, neither party here learned that the mailed notice was not delivered until September 9, 2015, when Applicant's counsel notified Opposer's counsel of this fact. See Day Decl. ¶ 4; Contrast Musical Directions, 104 U.S.P.Q.2d at 1158. It would be unjust to deny Opposer the opportunity to be heard merely because of a technical defect when there has been no harm to the Applicant.

C. Defective Service Can Be Cured

Applicant cites four federal appellate court decisions for the premise that defective service cannot be cured merely because the defendant had actual notice of a pleading. West v. Terry Bicycles, Inc., 2000 U.S. App. LEXIS 1791 (Fed Cir. 2000); Freedom Watch, Inc. v. OPEC, 766 F.3d 74, 81 (D.C. Cir. 2014); Albra v. Advan, Inc., 490 F.3d 826, 829 (11th Cir.

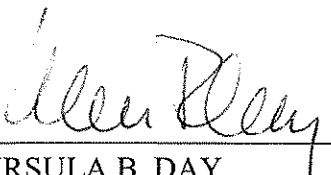
2007); Grand Entm't Grp., Ltd. V. Star Media Sales, Inc., 988 F.2d 476, 492 (3d Cir. 1993).

Since none of these cases were appeals of administrative hearings, or even trademark cases, none of them are relevant or binding. As has been demonstrated in the above-cited cases, including the one relied upon by Applicant, Musical Directions, actual but defective service of opposition petitions can be cured. Moreover, the Trademark Rules permit some leeway in administering the Federal Rules of Civil Procedures. See 37 C.F.R. § 2.116; Great Seats, Inc. v. Great Seats, Ltd., 100 U.S.P.Q.2D 1323, 1326 (TTAB 2011) ("Board inter partes proceedings are governed, in part, by the Federal Rules of Civil Procedure, except as otherwise provided in the Trademark Rules of Practice, and 'wherever [the Federal Rules are] applicable and appropriate.'"); Birlinn Ltd. v. Stewart, 111 U.S.P.Q.2D 1905 (TTAB 2014). Thus, the Board has, time and again, found defective service to be curable, at least where the Applicant has actual notice of the opposition.

CONCLUSION

For the foregoing reasons, the Board should find that Opposer has met the requirements for service under Trademark Rule 2.101 and deny Applicant's motion to dismiss.

Dated: October 1, 2015
New York, NY


URSULA B. DAY
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T: (212) 904-1815
patentlaw@ursuladay.net

Attorney for Opposer
Rive Gauche Jewelry, Inc.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----X	
RIVE GAUCHE JEWELRY, INC.,	}
	}
Opposer,	}
	}
v.	}
	}
LUXURY GOODS	}
INTERNATIONAL (L.G.I.), S.A.,	}
	}
Applicant.	}
-----X	

Mark:	RIVE GAUCHE (stylized)
Serial No.	86327529
Opp. No.	91223191

**DECLARATION OF URSULA DAY IN SUPPORT OF OPPOSER’S RESPONSE
AND IN OPPOSITION TO APPLICANT’S MOTION TO DISMISS**

I, Ursula B. Day, declare and state, under penalty of perjury as follows:

1. I am an attorney at the Law Firm of Ursula Day and am counsel to Rive Gauche Jewelry (“Opposer”) in the above-referenced action. I submit this Declaration in support of Opposer’s Response to Applicant’s Motion to Dismiss. The facts stated below are within my personal knowledge, and if called upon to testify hereto I can and will do so competently.

2. My office filed a Notice of Opposition to Applicant’s trademark registration with the United States Patent and Trademark Office (“USPTO”) via the Electronic System for Trademark Trial and Appeals (“ESTTA”) on August 7, 2015. The Notice of Opposition was filed with a Certificate of Service, indicating service on opposing counsel by facsimile or e-mail.

3. On August 7, 2015, I e-mailed the Notice of Opposition to Applicant’s counsel of record. Although the Certificate of Service only indicated service by e-mail, a copy of the opposition was also mailed on August 7, 2015 and Applicant’s counsel was advised as such by the same August 7, 2015 e-mail. A copy of the August 7, 2015 e-mail is attached as Exhibit A.

4. On August 7, 2015, I received confirmation from Applicant's counsel that the e-mailed Notice of Opposition was received.

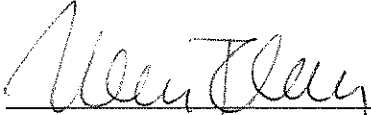
5. On September 9, 2015, I received an e-mail from Applicant's counsel advising me that it never received a hard copy of the Notice of Opposition, which was the first time my office learned the mailed Notice of Opposition was not received.

6. Immediately after learning that Applicant's counsel did not receive a hard copy of the Notice of Opposition, and on the same day, I mailed same to Applicant's counsel via U.S.P.S. Express Mail, which Applicant's counsel received the following day, September 10, 2015.

7. Applicant actually received the Notice of Opposition via e-mail, on August 7, 2015, and via U.S.P.S. Express Mail, on September 10, 2015.

I declare under penalty pursuant to the laws of the United States, 28 U.S.C. § 1746, that the foregoing is true and accurate.

Dated: October 1, 2015
New York, NY



Ursula B. Day

EXHIBIT A

Ursula Day

From: Ursula Day [patentlaw@ursuladay.net]
Sent: Friday, August 07, 2015 5:14 PM
To: 'Oren Gelber'
Subject: RE: Notice of Opposition



RIVEGAUCH
LRY.pdf (125

The attachment we sent you is the official acknowledgment of the TTAB with the timetable of the proceedings. You are receiving the Notice of Opposition that we filed by express mail and in the attachment here.

Best regards, Therese Balduzzi for

Ursula B. Day

-----Original Message-----

From: Oren Gelber [mailto:ogelber@collenip.com]
Sent: Friday, August 07, 2015 4:56 PM
To: Ursula Day
Subject: Re: Notice of Opposition

Also, this isn't a service copy of the Notice of Opposition . It's just the initiating order.

> On Aug 7, 2015, at 3:44 PM, Ursula Day <patentlaw@ursuladay.net> wrote:

>
> Please see forwarded mail and attachment.

>
> Best regards, Therese Balduzzi

>
> Ursula B. Day
> Attorney and Counselor at Law
> Intellectual Property
> 708 Third Avenue, Suite 1501
> New York, NY 10017
> voice 212-904-1815
> fax 212-244-2233

> Confidentiality Notice:
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> only for the use of the individual(s) to whom it is addressed. If you
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> dissemination, distribution or copying of this communication is
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> immediately notify the sender by telephone and delete or otherwise destroy all copies.
Thank you.

>
>
> -----Original Message-----

> From: ESTTA@USPTO.GOV [mailto:ESTTA@USPTO.GOV]
> Sent: Friday, August 07, 2015 3:09 PM
> To: patentlaw@ursuladay.net
> Subject: Notice of Opposition

>
> UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Trial and Appeal
> Board

>
> Opposition No. 91223191
> Application No. 86327529

>
> 08/07/2015
>
> IMPORTANT NOTICE
>
> A notice of opposition to registration has been filed with respect to
> the application listed above.
>
> The Trademark Trial and Appeal Board (TTAB) has issued an order
> instituting the opposition proceeding and setting trial dates. To see
> the order, click on the link below or paste the URL into the address
> box of your browser.
>
> <http://ttabvue.uspto.gov/ttabvue/v?pno=91223191&pty=OPP&eno=2>
>
> This order contains important information which you should review
> immediately. You must respond to the notice of opposition within
> forty days of this date. This will be the only notification of this
> order you will receive.
> An e-mail copy of the order itself will not be sent.
>
> If you are unable to view the order, call the TTAB for technical
> assistance at 571-272-8500. Do not use the reply button to respond to
> this message by e-mail.
>
> _____
>
> The entire public file of this proceeding may be viewed at
> <http://ttabvue.uspto.gov>.
>
> Papers in Board proceedings may be filed electronically with ESTTA at
> <http://estta.uspto.gov>.
>
> Further information is available at the TTAB's web page at
> <http://www.uspto.gov>.
>
>
> <OppositionRiveGauche.pdf>

**IN THE UNITED STATES PATENT AND TRADEMARKS OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Appl. Serial No.: 86/327,529

----- X
Rive Gauche Jewelry Inc.)

Opposer,)

vs.)

Luxury Goods)

International (L.G.I) S.A.)

Applicant.)
----- X

Opposition No.

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Pursuant to 15. U.S.C. §1063 Rive Gauche Jewelry Inc. ("Opposer"), a New York corporation having an address at 579 Fifth Avenue, NY 10017, believes it will be damaged by registration in International Class 14 of the mark shown in Application Serial No. 86/327,529 by Luxury Goods International (L.G.I.) S.A. ("Applicant"), and hereby opposes registration of the same.

As grounds of opposition, it is alleged that:

1. Opposer is the owner of the name and mark Rive Gauche Jewelry and the mark RG and design (RG) standing for Rive Gauche (hereinafter: the Marks), and owns valuable common law rights and trademark rights in these.
2. Opposer has used Rive Gauche Jewelry since at least as early as July 1, 2013 in connection with the sale of jewelry, personal ornaments of precious metal, wearable works of art of precious metal;
3. Opposer's goods are high end merchandise and it has sold and is selling to a discerning clientele. The merchandise comprises also unique pieces made to order.
4. Opposer has expended money, time, and effort over the past years, promoting and popularizing the Marks, and preserving the good will associated therewith.
5. By virtue of these efforts and the excellence of its goods, Opposer has gained a valuable reputation for its Marks within a short time, which have become distinctive of and associated in the minds of the trade and purchasing public with Opposer as a provider of beautiful jewelry.
6. On July 6, 2014, Applicant filed an application under Section 1(b) of the Lanham Act based, seeking to register the mark Rive Gauche and design ("Applicant's Mark"), in International Class 14, which application was assigned Serial No.86/327,529. Opposer opposes Applicant's application to register Applicant's Mark in Class 14 for the following goods:
"Precious metals and their alloys; works of art (of precious metal); jewelry (including costume jewelry) of precious metals, of alloys and plated, namely rings, earrings, cuff links, bracelets, brooches, pendants, charms, chains and watch chains, necklaces, medals, medallions; semi-precious stones and precious

stones; horological and chronometric instruments, watches, watch bands and watch cases; key rings of precious metals, of alloys or plated; cases for watches (presentation) and cases for clock making and watchmaking; jewelry cases and jewelry caskets."

7. Applicant's Mark was published for opposition in the Official Gazette of the United States Patent and Trademark Office on June 9, 2015.
8. Priority is not an issue: Opposer used its Marks in U.S. commerce with jewelry prior to Applicant's filing date, and Opposer has not abandoned its Marks.
9. Applicant's Mark is similar in appearance, sound, and commercial impression to Opposer's Marks.
10. The opposed goods in Class 14 identified in Application No. 86/327,529 are identical and/or closely related to the goods sold under Opposer's Marks.
11. Applicant's application to register Applicant's Mark in International Class 14, and any use Applicant may have made of said mark on the goods identified therein, are without Opposer's consent.
12. Applicant's Mark so resembles Opposer's Marks as to be likely, when applied to the goods of Applicant, to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). The aforesaid likelihood of confusion will damage Opposer within the meaning of 15 U.S.C. § 1063.
13. Applicant's Mark so resembles Opposer's Marks as to be likely, when applied to the goods of Applicant, to cause confusion, to cause mistake, or to deceive within the meaning of the Lanham Act, 15 U.S.C. §1125(a).

14. Opposer would be damaged by registration of Applicant's Mark in International Class 14 because registration would grant Applicant statutory rights under the Trademark Act of 1946, and would tend to restrict, interfere with, and damage Opposer in the unhampered conduct of its business and protection of its legitimate interests.

WHEREFORE, Opposer prays that Applicant's U.S. Trademark Application Serial No. 86/327,529 to register the mark Rive Gauche and design in International Class 14 be rejected, and that registration of said mark in International Class 14 be refused and denied.

The filing fee of \$300 is being submitted herewith by credit card.

Please direct all correspondence to Ursula B. Day, Esq., at Law Firm of Ursula B. Day, 708 Third Avenue Suite 1501, New York, New York 10017 and all calls to the same at (212) 904-815; e-mails to patentlaw@ursuladay.net

Respectfully submitted,

/ursula b. day/
Ursula B. Day, Esq.
Stefan Knirr, Esq.
Law Firm of Ursula B. Day,
708 Third Avenue Suite 1501, New York, New York 10017
patentlaw@ursuladay.net

Date: August 7, 2015

CERTIFICATE OF FILING

I certify that this NOTICE OF OPPOSITION is being submitted electronically to the Trademark Trial and Appeal Board at the United States Patent and Trademark Office on this 7th day of August, 2015.

/s/
Therese Balduzzi

URSULA B. DAY
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708 Third Avenue, Suite 1501
New York, New York 10017
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Attorney for Opposer
Rive Gauche Jewelry, Inc.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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RIVE GAUCHE JEWELRY, INC.,	}
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Opposer,	}
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v.	}
	}
LUXURY GOODS	}
INTERNATIONAL (L.G.I.), S.A.,	}
	}
Applicant.	}
-----X	

Mark:	RIVE GAUCHE (stylized)
Serial No.	86327529
Opp. No.	91223191

CERTIFICATE OF SERVICE

I hereby certify that on October 1, 2015, a copy of the foregoing Opposer's Opposition To Applicant's Motion To Dismiss, Declaration of Ursula B. Day and Exhibit A, were filed electronically with the United States Patent & Trademark Office, Trademark Trials & Appeals Board, in accordance with its procedures and served upon Applicant's Attorney of Record listed below via e-mail and First Class Mail to:

Jess M. Collen
Collen IP Intellectual Property Law, P.C.
80 South Highland Avenue
Ossining, New York 10562-5615
trademark@collenip.com



Therese Balduzzi